



Patent Rule and Procedural Changes

The Patent Office Comes to California

June 4 and 5, 2007

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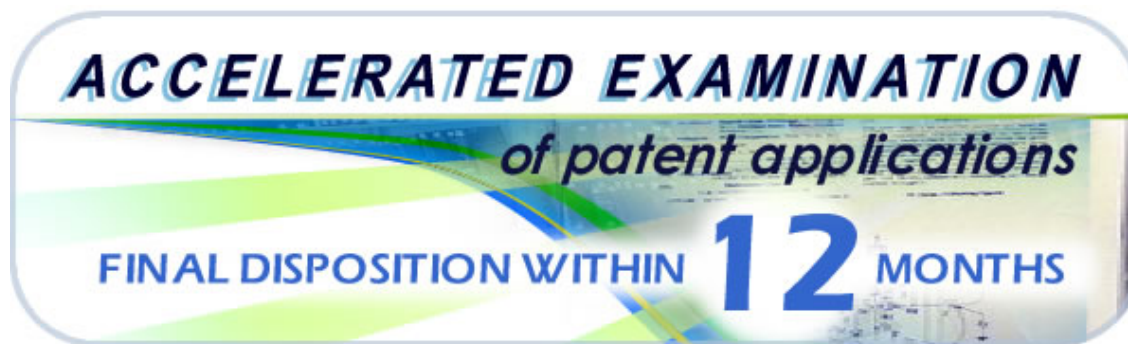


Topics

- ◆ Revised Accelerated Examination Program and Petition to Make Special Procedures;
- ◆ Intellectual Property Community Outreach;
- ◆ Status and Overview of Certain Notices of Proposed Rule Making;
- ◆ Changes to Facilitate Electronic Filing of Patent Correspondence (final rule);
- ◆ Changes to Implement Priority Document Exchange between Intellectual Property Offices (final rule); and
- ◆ Patent Prosecution Highway Pilot Program



Accelerated Examination Program





Patent Pendency

(as of 1/1/2007)

Technology Center	Average 1 st Action Pendency (months) ¹	Average Total Pendency (months) ²
1600 - Biotechnology and Organic Chemistry	22.2	34.7
1700 - Chemical and Materials Engineering	23.8	32.2
2100 - Computer Architecture Software and Information Security	29.4	43.4
2600 - Communications	33.4	42.3
2800 - Semiconductor, Electrical, Optical Systems	16.8	25.5
3600 - Transportation, Construction, Electronic Commerce	22.9	29.9
3700 - Mechanical Engineering, Manufacturing and Products	21.0	28.5
UPR Total (as of 1/1/2007)	23.4	31.3

¹ "Average 1st action pendency" is the average age from filing to first action for a newly filed application, completed during October-December 2006.

² "Average total pendency" is the average age from filing to issue or abandonment of a newly filed application, completed during October-December 2006.



Inventory by Art Examples

High Inventory Art Areas	Months of Inventory*	Low Inventory Art Areas	Months of Inventory*
1614, 1615, 1616 and 1617 – Drugs, Bio-affecting and Body Treatment	44	1620 – Organic Chemistry	15
1753 – Radiation Imagery	69	1713 – Polymer Chemistry	19
2140, 2150 – Computer Networks	45	2125 – Manufacturing Control Systems and Chemical/Mechanical/Electrical Control	12
2616 – Multiplex Communications	52	2613 – Optical Communications	24
2811 – Semiconductor Devices	29	2832 – Electronic Components	17
3620 – Business Methods	28-79	3651 – Conveying	16
3731 and 3737 – Medical Instruments, Diagnostic Equipment	42	3742 – Thermal and Combustion Technology	19

*The number of months it would take to reach a first action on the merits (e.g., an action addressing patentability issues) on an application filed today at today's production rate. "Today's production rate" means that there are no changes in production due to hiring, attrition, changes to examination processing or examination efficiencies, and that applications are taken up in the order of filing in the given art unit/area. Of course, USPTO is taking aggressive steps to ensure changes that will significantly lower the inventory rates in high-inventory art areas.



Accelerated Examination *Overview*

- GOAL: Achieve a final decision by the examiner within 12 months from the filing date
- Effective August 25, 2006
Petitions prior to this date are not included
- The new requirements apply to all petitions to make special, except for:
 - Age and health
 - Patent Prosecution Highway



Accelerated Examination *Benefits*

- Final patentability determination in 12 months
 - ✓ Good for inventions with a short life-span
 - ✓ Patent may be granted at the peak of the technology's life
 - ✓ Benefits inventions in very competitive markets
 - ✓ Information provided more quickly to those seeking to avoid infringement
- Claim drafting is more focused and clear
- Earlier and better interaction between applicant and examiner



Accelerated Examination *Filing Requirements*

The application must:

- Be filed electronically
- Be complete at filing
- Contain 3/20 total claims or fewer directed to a single invention
- Include a petition
- Include a fee (unless the claims are directed to environmental quality, energy, or countering terrorism)



Accelerated Examination

Filing requirements (cont.)

- The petition must include statements that applicant:
 - Will make election without traverse
 - Will have an interview
 - Will not separately argue any dependent claim during appeal
- The petition must be accompanied by:
 - A pre-examination search
 - An accelerated examination support document (ESD)



Accelerated Examination *Review within the USPTO*

- Petition will be initially denied if:
 - It fails to meet filing requirements
 - Application is not eligible (plant, reissue, re-exam, 371)
- Petition will be dismissed if it has defects:
 - Defects will be specifically noted
 - Applicant has one chance to cure
- Petition will be ultimately denied if:
 - Applicant was unable to cure defects in prescribed time period



Accelerated Examination

The Pre-examination Search

- The pre-examination search must include a search of:
 - U.S. Patents
 - Patent application publications
 - Foreign patent documents
 - Non-patent literature
- Search directed to the claimed invention giving claims their broadest reasonable interpretation
- Include a classified search and text search



Accelerated Examination *If the Search is Deficient*

Petition Dismissal or Denial:

- Will include specifics of deficiency with suggestions for overcoming it
- *Unless* it is readily apparent that the applicant's search is wholly deficient
Here, only general guidance directed at improving the search will be given in the decision



Accelerated Examination

The Examination Support Document

The accelerated examination support document must include:

- An information disclosure statement citing each reference deemed most closely related to the claims
- An identification of where each limitation disclosed in each reference is found
 - Refer to specific paragraphs or drawing elements
- A detailed explanation of how each claim is patentable over each reference
 - Be specific – general statements are not sufficient



Accelerated Examination

The Examination Support Document

- A concise statement of utility of the invention
- A showing of support for each claim limitation in specification
 - Point to page, line numbers or drawing elements
- An identification of any cited references that may be disqualified as prior art under 35 U.S.C. 103(c)



Accelerated Examination *Examination Processing*

- The application will be taken up for action shortly after petition decision
- The examiner will complete a prior art search
- Prior to any first Office action rejection:
 - Conference held to confirm rejection
 - Telephone or personal interview is conducted
- An additional conference will be held prior to any final rejection



Accelerated Examination

Applicant's Reply

- Shorter Statutory Periods (SSP) for applicant reply:

1-month (or 30 days) SSP for any action except final rejection or allowance

No time extensions under *Section 1.136(a)* - only *1.136(b)*.

Timely reply failure results in abandonment

- If response includes either amended or newly-added claims:

An updated search will be required if claims are not encompassed by the pre-examination search

An updated AE support document will be required if claims are not encompassed by original AE support document



Accelerated Examination

Applicant's Reply

The Office will treat any amendments (including after final amendments and RCE submissions) as not being fully responsive if the amendment:

- Exceeds the 3/20 claim limit;
- Presents claims to a non-elected invention;
- Presents claims not encompassed by the pre-examination search, or an updated search; or
- Presents claims requiring an updated AE support document, which is not submitted.



Accelerated Examination

Tips for Getting a Petition Granted

- Search the claimed invention. The search must be commensurate in scope with the claims.
- Search should include U.S. Patents and pubs, foreign patents & pubs and non-patent literature.
- Provide the text search logic. A listing of terms will not suffice.
- Show support in the specification and/or drawings for each limitation of each claim. Be specific.
- Clearly and specifically identify the limitations in each claim found in each reference. A chart is a clear, convenient format.
- Clearly point out by specific claim language how each claim is patentable over each reference.



Accelerated Examination

Information Links

- *AE Home Page:* <http://www.uspto.gov/web/patents/accelerated>
- *AE Federal Register Notice:*
<http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.pdf>
- *Sample AE Petition Form SB/2B:* http://www.uspto.gov/web/forms/sb0028_fil.pdf
- *Sample AE Pre-Examination Search Document:*
http://www.uspto.gov/web/patents/accelerated/ae_presearch_sample.doc
- *Sample AE Support Document:*
http://www.uspto.gov/web/patents/accelerated/ae_support_document_sample.doc
- *FAQs:* http://www.uspto.gov/web/patents/accelerated/ae_faq.htm



Notices of Proposed Rule Making

- ◆ Changes to Practice for Continuing Applications, Requests for Continued Examination Practice and Applications Containing Patentably Indistinct Claims (proposed rule) (Continued Examination NPR);
- ◆ Changes to Practice for the Examination of Claims in Patent Applications (proposed rule) (Claims NPR); and
- ◆ Changes to Information Disclosure Statement Requirements and Other Related Matters (proposed rule)(IDS NPR).



Claims and Continued Examination NPRs

- ◆ Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims,
 - ◆ 71 FR 481 (Jan. 3, 2006); 1302 *Off. Gaz. Pat. Off.* 1318 (Jan. 24, 2006)
- ◆ Changes to Practice for the Examination of Claims in Patent Applications,
 - ◆ 71 FR 61 (Jan. 3, 2006); 1302 *Off. Gaz. Pat. Off.* 1329 (Jan. 24, 2006)
- ◆ The comment period ended on May 3, 2006.
- ◆ All comments posted on USPTO website:
http://www.uspto.gov/web/offices/pac/dapp/opla/comments/fpp_claims/claims_comments.html; and
http://www.uspto.gov/web/offices/pac/dapp/opla/comments/fpp_continuation/continuation_comments.html



Claims and Continued Examination NPRs

- ◆ The Office received:
 - ◆ Over **330** comments on the Continued Examination NPR; and
 - ◆ Over **180** comments on the Claims NPR.
- ◆ The final rule is under review at the Office of Management and Budget (OMB).
 - ◆ OMB received date: April 10, 2007.
 - ◆ The review by OMB will likely take 90 days.
 - ◆ The final rule under review at OMB is privileged.
 - ◆ The USPTO is not at liberty to discuss the specifics of the final rule under review at OMB.
- ◆ The final rule will provide at least 30 days between the publication date of the final rule and the effective date.



Public Comments on IDS NPR

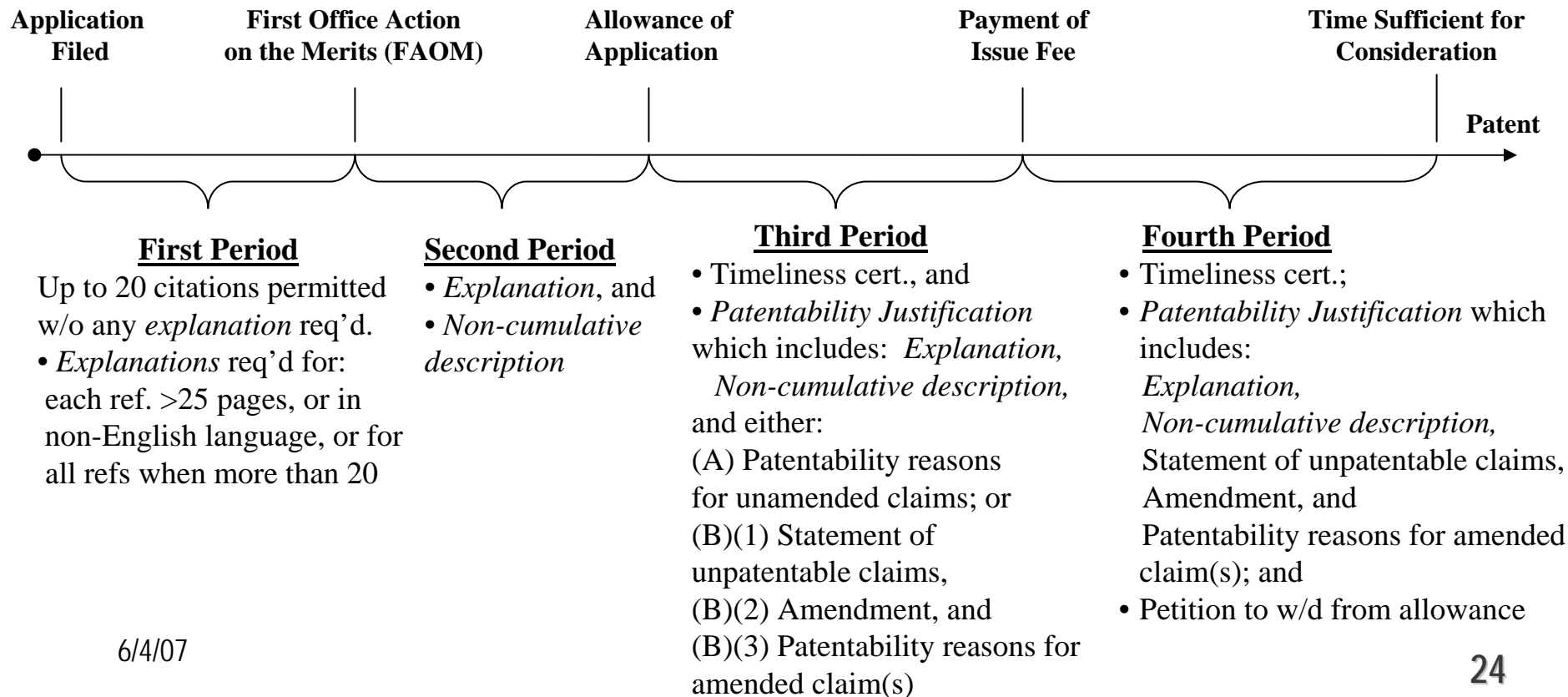
- ◆ The Office received over 60 comments on the IDS NPR.
- ◆ The comments are posted on the USPTO website at:
<http://www.uspto.gov/web/offices/pac/dapp/opla/comments/ab95/ids.htm>.
- ◆ The Office is considering all the public comments.
 - All comments and suggestions are being analyzed in view of the goals and objectives set forth in the IDS NPR.
- ◆ No decision has been made as to the content of any final rule.



Proposed Changes in IDS NPR

Time Periods 1- 4

Application Prosecution Timeline and corresponding IDS requirements





Proposed Changes in IDS NPR

- ◆ **Time Period 1:** Between the filing date (or national stage entry date) of the application and the later of: 3 months from filing or before the mailing of the first Office action on the merits (FAOM).
- ◆ An explanation in compliance with proposed § 1.98(a)(3)(iv) would be required for each of the following:
 - ◆ All documents when the applicant cited more than 20 documents in IDS(s) filed during time period 1;
 - ◆ Any English-language document over 25 pages excluding sequence and computer listings;
 - ◆ Any translation of a non-English document that exceeds 25 pages.
- ◆ **Exceptions:** Documents cited in a foreign search or examination report, and documents submitted in a reply to a requirement for information under § 1.105.



Proposed Changes in IDS NPR

An explanation in compliance with proposed § 1.98(a)(3)(iv) must include:

A. An identification of:

- ◆ The specific feature(s), showing(s), or teaching(s) that caused the document to be cited; and
- ◆ A portion of the document where the specific feature(s), showing(s), or teaching(s) may be found.

B. A correlation of:

- ◆ The specific feature(s), showing(s), or teaching(s) to
- ◆ The corresponding specific claim language, or to a specific portion(s) of the supporting specification, where the document is cited for that purpose.



Proposed Changes in IDS NPR

- ◆ **Time Period 2:** Between the end of time period 1 and before the earlier of: the mailing of a notice of allowability or a notice of allowance (or a notice of intent to issue a reexamination certificate).
- ◆ For each document cited in an IDS that is filed in time period 2, the IDS must include:
 - ◆ An explanation in compliance with proposed § 1.98(a)(3)(iv); and
 - ◆ A non-cumulative description in compliance with proposed §1.98(a)(3)(v).
 - ◆ A description of how each document is not merely cumulative of any other document cited in any prior or current IDS, or any information cited by the examiner.
- ◆ **Exceptions:** Documents cited with a certification under § 1.97(e)(1) and a foreign search or examination report; and documents submitted in a reply to a requirement for information under § 1.105.



Proposed Changes in IDS NPR

- ◆ **Time Period 3:** Between the end of time period 2 and the payment of the issue fee.
- ◆ For each document cited in an IDS that is filed in time period 3, the IDS must include:
 - ◆ A certification under § 1.97(e)(1) or § 1.97(e)(2); and
 - ◆ Patentability justification in compliance with § 1.98(a)(3)(vi), including:
 - ◆ An explanation in compliance with proposed § 1.98(a)(3)(iv);
 - ◆ A non-cumulative description in compliance with proposed § 1.98(a)(3)(v); and
 - ◆ Either: (A) patentability reasons for unamended claims; or
(B) a statement of unpatentable claims, an amendment, and patentability reasons for the amended claims.



Proposed Changes in IDS NPR

- ◆ **Time Period 4:** Between the end of time period 3 and in sufficient time to be considered by the examiner before issuance of the application.
- ◆ For each document cited in an IDS that is filed in time period 4, the IDS must include:
 - ◆ A certification under § 1.97(e)(1) or § 1.97(e)(2);
 - ◆ A petition to withdraw the application from issue; and
 - ◆ Patentability justification in compliance with § 1.98(a)(3)(vi)(B), which includes:
 - ◆ An explanation in compliance with proposed § 1.98(a)(3)(iv);
 - ◆ A non-cumulative description in compliance with proposed § 1.98(a)(3)(v); and
 - ◆ A statement of unpatentable claims, an amendment, and patentability reasons for the amended claims.



Changes to Facilitate Electronic Filing of Patent Correspondence (final rule)



Electronic Filing Final Rule

- ◆ The rules of practice have been changed to support implementation of the Office's Web-based electronic filing system (EFS-Web).
 - ◆ *Changes to Facilitate Electronic Filing of Patent Correspondence*, 72 FR 2770 (Jan. 23, 2007), 57 *Off. Gaz. Pat. Off.* 1315 (Feb. 13, 2007) (final rule).
- ◆ EFS-Web permits most patent correspondence to be electronically submitted in a portable document file ("PDF") format.
 - ◆ See the Legal Framework for EFS-Web for a current list of types of correspondence that are not permitted to be filed using EFS-Web.



Electronic Filing Final Rule

- ◆ Applicant may electronically submit via EFS-Web the following:
 - ◆ Non-reissue applications;
 - ◆ Amendments and other replies;
 - ◆ Information disclosure statements (IDSs);
 - ◆ Requests for continued examination (RCEs);
 - ◆ Sequence listings (§ 1.821(c) or (e));
 - ◆ Computer program listings (§ 1.96);
 - ◆ Tables (§ 1.58); and
 - ◆ Amended or redacted versions of applications for the purposes of publication under § 1.215(c) or § 1.217(b).



Electronic Filing Final Rule

- ◆ Certain documents are not permitted to be filed via EFS-Web, such as:
 - ◆ A request for reexamination;
 - ◆ Any other documents related to reexaminations;
 - ◆ Submissions regarding reissue applications;
 - ◆ Correspondence in an application that is subject to a secrecy order;
 - ◆ Third party submissions under § 1.99;
 - ◆ Protests under § 1.291
 - ◆ Public use hearing papers under § 1.292;
 - ◆ Submissions in contested cases before the Board of Patent Appeals and Interferences (BPAI), unless the BPAI expressly authorizes; and
 - ◆ Correspondence related to a disciplinary proceeding.



Electronic Filing Final Rule

- ◆ EFS-Web provides the following fillable forms:
 - ◆ Information Disclosure Statement;
 - ◆ Application Data Sheet (must be signed if the ADS includes a nonpublication request);
 - ◆ Request for Continued Examination (RCE);
 - ◆ Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent; and
 - ◆ Petition to Make Special Under Accelerated Examination Program.
- ◆ The Office will continue to convert additional forms to the PDF form-fillable format.



Electronic Filing Final Rule

- ◆ For purposes of determining the application size fee under §1.16(s)
 - ◆ The paper size equivalent of the specification and drawings of an application (including preliminary amendments) submitted via EFS-Web is **75%** of the number of sheets of paper present in the specification and drawings of the application when entered into the Office's IFW system; and
 - ◆ Any sequence listing in compliance with § 1.821(c) or (e), and any computer program listing in compliance with § 1.96, submitted via the Office's EFS-Web will be **excluded if the listing is submitted in ASCII text as part of an associated file** (rather than in PDF format).
 - ◆ See § 1.52(f)(2).



Electronic Filing Final Rule

Certificate of EFS-Web transmission:

- ◆ The Office will treat certain correspondence as received (for timeliness purposes) as of the date submitted by applicant rather than the date received by the Office if:
 - ◆ The correspondence was filed by EFS-Web and
 - ◆ A certification of EFS-Web transmission under § 1.8 was filed with the correspondence.
- ◆ Applicant should keep a copy of the correspondence submitted and the certification of EFS-Web transmission under § 1.8 as evidence to support an argument that the correspondence was submitted at a particular **local time**.



Electronic Filing Final Rule

- ◆ An acknowledgement receipt will contain:
 - ◆ The date of receipt by the Office of the electronic documents submitted; and
 - ◆ A full listing of the correspondence submitted to the Office as described by applicant during the submission process, including the count of pages and/or byte sizes for each document.
- ◆ Receipt date – the date the correspondence is received by the Office (*e.g.*, in Alexandria, VA (Eastern Time Zone)).
 - ◆ It is not limited to an official business day, but can be a Saturday, Sunday or Federal holiday.
- ◆ The acknowledgement receipt is a legal equivalent of a post card receipt described in MPEP § 503.



Electronic Filing Final Rule

- ◆ Each submission session must be limited to correspondence for a single application, with each distinct reply being contained in a separate paper.
- ◆ The application number or the patent number for which the correspondence pertains must be included in any submission to assure proper matching with the application file.
- ◆ Applicant should review the application filed via EFS-Web in PAIR to determine whether submission is complete.
- ◆ Applicant should not:
 - ◆ Submit documents to multiple applications in one single EFS-Web submission;
 - ◆ Submit a required reply piecemeal over multiple sessions.



Electronic Filing Final Rule

- ◆ If a transmission is attempted during a time when the EFS-Web is down, the Office will not be able to accept any correspondence electronically.
- ◆ Applicant is advised to use alternative filing methods:
 - ◆ For filing an application – Express Mail under § 1.10 or hand-delivery to the Office;
 - ◆ Other patent correspondence (*e.g.*, an amendment) – First-Class mail with a certificate of mailing under § 1.8 (if applicable), facsimile transmission with a certificate of transmission under § 1.8 (if applicable), Express Mail under § 1.10, or hand-delivery to the Office.



Electronic Filing Final Rule

- ◆ Applicants are strongly advised to submit their correspondence via EFS-Web sufficiently early in the day to allow time for alternative filing or payment methods when submissions via EFS-Web or RAM cannot be initiated or correctly completed.
- ◆ The Office is capable of accepting electronic patent application filings every day of the week, including weekends and holidays, via EFS-Web. Check the USPTO's website for any scheduled outages.
- ◆ For assistance regarding EFS-Web, contact Electronic Business Center at 1-866-271-9197 or ebc@uspto.gov.



Changes to Implement Priority Document Exchange Between Intellectual Property Offices,

72 FR 1664 (January 16, 2007), 1315 *Off. Gaz. Pat Office* 63
(Feb. 13, 2007) (final rule)

More information regarding the priority document exchange program is
available at http://www.uspto.gov/main/faq/faq_pdx.html.



Priority Document Exchange

- ◆ The Office has been negotiating agreements with other patent offices to permit the Office to obtain and provide electronic copies of priority documents.
 - ◆ Agreements to obtain and provide such copies have been established with the European Patent Office (EPO) and its member states.
 - ◆ Agreements are being considered with the Japan Patent Office (JPO).
 - ◆ Both offices will have the technical ability to provide and retrieve certified electronic copies of priority documents via automated mechanisms.



Priority Document Exchange

- ◆ If an applicant makes a proper request and an electronic copy of the counterpart foreign application is imported from another participating intellectual property (IP) office by the Office,
 - ◆ The obligation to provide a certified copy of the foreign application would be satisfied.
 - ◆ The applicant, however, may be required to provide an English translation of a non-English foreign application.

For example:

- ◆ If applicant claims foreign priority under § 1.55 to an application filed in the EPO, applicant may request that the Office retrieve an electronic copy of the EPO application rather than filing a certified copy of the foreign application on paper.



Priority Document Exchange

- ◆ The agreements will also enable a participating IP office to obtain an electronic copy of a priority document of an application that was filed in a non-participating IP office from another participating IP office in which a certified copy of the priority document has been filed and stored.
- ◆ For example:
 - ◆ If applicant claims priority under § 1.55 to a foreign application and a certified copy of the foreign application has been filed in an EPO application, applicant may request that the Office retrieve an electronic copy of a foreign application that was filed in the EPO application.



Priority Document Exchange

- ◆ The requirement for the certified copy under § 1.55(a)(2) will be considered satisfied if:
 - ◆ The applicant files a request (PTO/SB/38)
 - ◆ The request should be filed within the later of 4 months from the filing date of the application or 16 months from the foreign priority date;
 - ◆ The foreign application is identified in the oath or declaration (§ 1.63) or an application data sheet (§ 1.76); and
 - ◆ The copy of the foreign application is received by the Office within the period set forth in § 1.55(a) (*e.g.*, before the payment of the issue fee).



Priority Document Exchange

Request to Retrieve Electronic Priority Application(s) (PTO/SB/38)

Doc Code: PD.REQ.RETR

PTO/SB/38 (04-07)

Approved for use through 09/30/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Request to Retrieve Electronic Priority Application(s)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

COMPLETE IF KNOWN

Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Attorney Docket Number	

The undersigned hereby requests the USPTO retrieve an electronic copy of each of the following foreign applications for which benefit has been claimed under 35 U.S.C. 119(a)-(d) from a foreign intellectual property office participating with the USPTO in a bilateral or multilateral priority document exchange agreement:

Please retrieve (check all that apply)

- ☐ The following applications originally filed in participating offices (only list the Participating Office and the Participating Office Application Number (columns 1 and 2 below)):
- ☐ The following applications originally filed in non-participating offices (must list the information for all three columns below):

1. Participating Office with which the Priority Application, or the Copy, was filed (e.g., EPO)	2. Participating Office Application Number in which the Priority Application, or a Copy, was filed (e.g., 03101432)		3. Non-Participating Office Application Number (Priority Application), if applicable	
	App. No.	Filing Date	Office	App. No.
1.				
2.				
3.				
4.				
5.				
6.				

This Request to Retrieve Electronic Priority Application(s) (Request) should be filed within the later of four months from the date of filing the above-identified application claiming foreign priority, or sixteen months from the filing date of the foreign application to which priority is claimed.

This Request should be submitted concurrently with the claim for priority, or thereafter. The USPTO will not



Priority Document Exchange

- ◆ Upon receipt of a timely filed request, the Office will make at least two attempts to retrieve a copy of the foreign application from the participating office.
- ◆ Applicants should consult the private Patent Application Information Retrieval (PAIR) system to determine if the copy of the foreign application was retrieved by the Office.
- ◆ Applicants should contact the Electronic Business Center, rather than the examiner, if the copy of the foreign application has not been entered in the application IFW file.



Priority Document Exchange

- ◆ The agreements also permit another participating IP office to obtain electronic copies of priority documents from the Office (at no charge to the applicant).

For example:

- ◆ If an EPO application claims foreign priority to an US application, the EPO will automatically attempt to retrieve an electronic copy of the US application-as-filed.



Priority Document Exchange

- ◆ The Office will provide an electronic copy of the US application-as-filed via the PDX system to the EPO if :
 - ◆ The US application has cleared national security review; and
 - ◆ A written authorization (PTO/SB/39) under § 1.14(h) granting access to the US application-as-filed under the PDX program was filed in the US application.
 - ◆ The written authorization should be submitted prior to the filing of the EPO application to ensure that it is likely that the EPO will be successful in its attempt to retrieve a copy of the priority application from the Office.
 - ◆ A written authority is not required if the US application has been published or patented.



Priority Document Exchange

Authorization to Permit Access to Application by Participating Office (PTO/SB/39)

Doc Code: PD.TO.AUTH

PTO/SB/39 (04-07)
Approved for use through 09/30/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

AUTHORIZATION TO PERMIT ACCESS TO APPLICATION BY PARTICIPATING OFFICES

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

	COMPLETE IF KNOWN
Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Attorney Docket Number	

The undersigned hereby grants the USPTO authority under the Trilateral Document Access (TDA) Program to provide the European Patent Office (EPO) access to the above-identified patent application, entitled:

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In accordance with 37 CFR 1.14(h)(3), access will be provided to a copy of the application-as-filed with respect to: 1) the above-identified application, 2) any foreign application to which the above-identified application claims priority under 35 USC 119(a)-(d), and 3) any U.S. application from which benefit is sought in the above-identified application.

This written authorization should be submitted prior to the filing of a subsequent foreign application with the EPO in which priority is claimed to the above-identified application.

No fee will be charged under 37 CFR 1.19(b)(1) for providing the EPO with an electronic copy of the above-identified application.

This form must be signed by an authorized party in accordance with 37 CFR 1.14(c).



Priority Document Exchange

PDX Limitations:

- ◆ The PDX system can only process priority documents that contain about 1,000 pages or fewer.
 - ◆ For very large documents, applicants should file the paper certified copy of the foreign applications.
- ◆ PCT International Applications are excluded from the PDX program, which includes:
 - ◆ Retrieving or transmitting any international applications as a priority document; and
 - ◆ Requesting retrieval of any priority document for placement within an international application.



Patent Prosecution Highway Pilot Program



Patent Prosecution Highway Pilot Program

- ◆ The USPTO and the Japan Patent Office (JPO) worked together to establish the PPH Pilot Program.
 - ↪ *See Patent Prosecution Highway Pilot Program between the United States patent and trademark Office and the Japan Patent Office, 1307 Off. Gaz. Pat. Office 61 (June 13, 2006); and*
 - ↪ *Revised Requirements for Requesting Participation in the Patent Prosecution Highway Pilot Program in the USPTO, 1314 Off. Gaz. Pat. Office 1398 (Jan. 30, 2007).*
- ◆ The pilot program commenced on July 3, 2006, for a period of one year. It may be extended for up to an additional year if necessary to adequately assess the feasibility of the program.



Patent Prosecution Highway Pilot Program

- ◆ Applicants whose claim(s) is determined to be patentable in the office of first filing may request that the corresponding application filed in the office of second filing be advanced out of turn for examination provided certain conditions are satisfied.
- ◆ The office of second filing would be able to exploit the search and examination results of the office of first filing.
- ◆ Applicant may be able to obtain a patent on the corresponding application filed in the office of second filing faster.



Patent Prosecution Highway Pilot Program

- ◆ If the USPTO is the office of first filing and the U.S. application contains claims that are determined to be allowable, applicants may request to have the corresponding application filed in the JPO advanced out of turn for examination in the JPO.
- ◆ The procedures and requirements for filing a request to the JPO for participation in the PPH pilot program are available from the JPO web site at: <http://www.jpo.go.jp/>.



Patent Prosecution Highway Pilot Program - Requirements

- ◆ If the JPO is the office of first filing and the JPO application contains claims that are determined to be allowable, applicant may petition to make the U.S. application special under the PPH pilot program.

Requirements:

- ◆ The U.S. utility application filed under 35 U.S.C. 111(a) must claim foreign priority to the JPO application under 35 U.S.C. 119(a)-(d) and §1.55.
- ◆ The JPO application must contain at least one claim that was determined by the JPO to be allowable.



Patent Prosecution Highway Pilot Program - Requirements

Requirements (continued) - Applicant must file:

- ◆ A request for participation in the PPH pilot program, and a petition to make special accompanied by the petition fee under § 1.17(h) (see PTO/SB/20) prior to the first Office action on the merits;
- ◆ A copy of all JPO office actions (excluding "Decision to Grant a Patent"), an English translation thereof, and a statement that the English translation is accurate;
- ◆ An information disclosure statement (IDS) under §§ 1.97 and 1.98 listing the documents cited by the JPO examiner; and
- ◆ A copy of the allowable claims in the JPO application, an English translation thereof and a statement that the English translation is accurate.



Patent Prosecution Highway Pilot Program - Requirements

Requirements (continued):

- ◆ All the claims in the U.S. application (including any subsequently amended or added claims) must sufficiently correspond to the allowable claims in the JPO application.
 - ↪ The claims must have the same or similar scope.
 - ↪ They could have differences due to translations and claim format requirements.
- ◆ Applicant must submit a claims correspondence table in English to indicate how all of the claims in the U.S. application correspond to the allowable claims in the JPO application (see PTO/SB/20).
 - ↪ Updated claims correspondence table may be required for an amendment to the claims.



Patent Prosecution Highway Pilot Program - Requirements

Requirements (continued):

- ◆ Examination of U.S. application has not begun.
- ◆ The request and supporting documents must be filed via facsimile to 571-273-0125, directed to Magdalen Greenlief.
- ◆ More information regarding the PPH pilot program is available at http://www.uspto.gov/web/patents/pph/pph_index.html.



Patent Prosecution Highway Pilot Program

Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program Between the JPO and the USPTO(PTO/SB/20)



PTO/SB/20 (01-07)
Approved for use through 12/31/2008. OMB 0651-0058
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM BETWEEN THE JPO AND THE USPTO			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			
THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM MUST BE FAXED TO: THE OFFICE OF THE COMMISSIONER FOR PATENTS AT 571-273-0125 DIRECTED TO THE ATTENTION OF MAGDALEN GREENLIEF			
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.			
The above-identified application validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more corresponding JPO application(s).			
The JPO application number(s) is/are: _____			
The filing date of the JPO application(s) is/are: _____			
I. List of Required Documents:			
a. A copy of all JPO office actions (<u>excluding</u> "Decision to Grant a Patent") in the above-identified JPO application(s).			
<input type="checkbox"/> Is attached.			
<input type="checkbox"/> Is available via Dossier Access System. Applicant hereby requests that the USPTO obtain these documents via the Dossier Access System.			
*It is <u>not</u> necessary to submit a copy of the "Decision to Grant a Patent" and an English translation thereof.			
b. A copy of all claims which were determined to be patentable by the JPO in the above-identified JPO application(s).			
<input type="checkbox"/> Is attached.			



Thank You!